

Application Number 10/788,591
Amendment dated February 2, 2005
Responsive to Office Action mailed December 30, 2004

REMARKS

This amendment is responsive to the Office Action mailed December 30, 2004. Applicant has amended claims 1, 10 and 14. Claims 1-20 are still pending.

Claim Rejection Under 35 U.S.C. § 112

In the Office Action, the Examiner rejected claims 1-10 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner objected to the phrase "the housing and the host connector protruding from the housing define memory card dimensions which substantially conform to dimensions of a memory card standard." The Examiner stated that if there is a protruding connector, the housing is not in conformity in shape to a memory card standard. The Examiner did not consider this limitation in examining the claims.

Applicant has amended claim 1 to remove the limitation identified by the Examiner as rendering claim 1 indefinite. Since the Examiner did not consider this limitation in examining the claims, removal of this limitation should not raise any issues and concerns, and should overcome the rejection under 35 U.S.C. § 112, second paragraph, to place this claim into condition for allowance.

Applicant nevertheless wishes to comment briefly on the Examiner's remarks. In particular, Applicant notes that the height and width dimensions of the memory card may conform to dimensions of a memory card standard even if the "shape" or "form factor" of the memory card does not conform to that of the memory card standard. For example, as illustrated in FIG. 1 memory card 2 may define a height (H) and a width (W), which comply with dimensions of a memory card standard, even if host connector 4 protrudes in a manner that makes the "shape" or "form factor" of memory card 2 different from the shape contemplated by the standard. In any case, Applicant submits that the current amendment to claim 1 renders this point moot, and places this claim into condition for allowance.

The Examiner also rejected claim 10 under 35 U.S.C. 112, second paragraph, noting that the phrase "the retractable sheath" lacks a proper antecedent basis. Applicant has amended claim 10 to depend upon claim 9, which should overcome this rejection.

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The Examiner also rejected claim 14 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. For this claim, the Examiner stated that independent claim 11 recites a sheath, and that the dependent limitation of claim 14, which recites a shieldless tab, is a contradiction insofar as the sheath could be construed as a shield for the tab. In order to address the Examiner's concern with respect to claim 14, Applicant has amended claim 14 to recite a tab rather than a shieldless tab. Applicant submits that claim 14, as amended, complies with 35 U.S.C. 112, second paragraph.

Rejection for Obviousness-type Double Patenting:

The Examiner also rejected claims 1-4 and 7-8 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of co-pending Application Number 10/788,591.

The Examiner also rejected claims 5 and 6 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of co-pending Application Number 10/788,591 in view of Ballai (US 2004/0034861).

The Examiner also rejected claims 9-13 and 15-20 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of co-pending Application Number 10/788,591 in view of Liu et al. (US 6,567,273).

Applicant respectfully points out that Application Number 10/788,591 is the current application, and not a co-pending application as stated by the Examiner. However, from the Examiner's initial comments in the Office Action, it appears that the rejections summarized above were meant to be based on Application Number 10/788,600 rather than Application Number 10/788,591. The Examiner also noted that similar double patenting rejections might be similarly made with respect to Application Numbers 10/644,484, 10/788,594 and 10/788,623. The Examiner suggested that Applicant submit a terminal disclaimer for the current application with respect to Application Numbers 10/788,600, 10/644,484, 10/788,594 and 10/788,623.

Submitted herewith is a Terminal Disclaimer for this application with respect to U.S. Patent Application Numbers 10/788,600, 10/644,484, 10/788,594 and 10/788,623. The Terminal Disclaimer submitted herewith should overcome all of the Examiner's rejections for

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obviousness-type double patenting. The Terminal Disclaimer is being submitted for the purpose of expediting this case to immediate issuance. Applicant does not necessarily agree or acquiesce to any of the Examiner's double patenting rejections, particularly those that relate to U.S. Patent Application Numbers 10/644,484, 10/788,594 and 10/788,623 that the Examiner did not explain.

CONCLUSION

All claims in this application are in condition for allowance. Applicant respectfully requests reconsideration and prompt allowance of all pending claims. Please charge any additional fees or credit any overpayment to deposit account number 09-0069. The Examiner is invited to telephone the below-signed attorney to discuss this application.

Date:

2/2/5

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